

IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF TEXAS  
DALLAS DIVISION

PRINTING RESEARCH, INC.,  
HOWARD W. DEMOORE,

Plaintiffs,

v.

WILLIAMSON PRINTING CORP.,  
BILL L. DAVIS, and  
JESSE S. WILLIAMSON,

Defendants.

§  
§  
§  
§  
§  
§  
§  
§  
§  
§  
§

CIVIL ACTION NO. 3-99CV1154-M

PLAINTIFFS' EXPERT DESIGNATION AND REPORTS

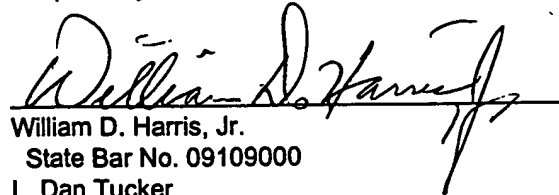
09/15/99 09:24:00  
Plaintiffs, Printing Research, Inc. and Howard W. DeMoore, (collectively "Plaintiffs"), designate the following as experts for this action and herewith submit their reports as Exhibit A and Exhibit B under Rule 26(a)(2):

Professor W.S. Mott  
2359 Leona Avenue  
San Luis Obispo, CA 93401-5368

Warren B. Kice  
Haynes and Boone, LLP  
901 Main Street, Suite 3100  
Dallas, Texas 75202-3789

The report of Dr. Mott, who lives in California, was sent by fax. A signed ribbon copy will be tendered for filing when it arrives. It is expected on October 6, 2000.

Respectfully submitted:

  
William D. Harris, Jr.  
State Bar No. 09109000

L. Dan Tucker  
State Bar No. 20276500  
Stephen D. Wilson  
State Bar No. 24003187  
LOCKE LIDDELL & SAPP LLP  
2200 Ross Avenue, Suite 2200  
Dallas, Texas 75201-6776  
(214) 740-8000  
(214) 740-8800 (facsimile)

Martin J. Sweeney  
State Bar No. 19570550  
COZEN AND O'CONNOR  
2300 BankOne Center, 1717 Main Street  
Dallas, TX 75201  
(214) 462-3024  
(214) 462-3299 (facsimile)

ATTORNEYS FOR PLAINTIFFS

**CERTIFICATE OF SERVICE**

I hereby certify that the foregoing "Plaintiffs' Expert Designation and Reports" was served on Defendants' counsel by United States Postal Service Express Mail on October 5, 2000:

John P. Pinkerton  
WORSHAM, FORSYTHE & WOOLDRIDGE, L.L.P.  
1601 Bryan, 30th Floor  
Dallas, Texas 75201  
(214) 979-3065  
(214) 880-0011 (Facsimile)

  
Attorney for Plaintiffs

0345796-0540  
T04250-9625E60

## Printing Research, Inc. v. Williamson Printing Corporation

### LEGAL EXPERT'S REPORT

My name is Warren Kice and my curriculum vitae is attached. I have been a partner with the law firm of Haynes and Boone since 1987 and have 37 years of experience in patent law. I have been retained as an expert witness by the law firm of Locke, Liddell and Sapp. My compensation is \$410 per hour.

In the past, I have been designated as an expert witness and deposed in the following lawsuits:

1. Printing Research v. John Bird d/b/a JB Machinery, Inc.; JB Machinery, Inc., and Absolute Images, Inc. d/b/a The Nelson Group, Inc.
2. Mountain Math, Inc. v. Summit Educational Enterprises, Inc.

My latest publication is a document entitled: "Writing and Prosecuting Winning Patents, published on August 26, 2000.

In connection with the present lawsuit I have reviewed at least a portion of each of the following documents:

1. Patent Application entitled "RETRACTABLE INKING/COATING APPARATUS HAVING FERRIS MOVEMENT BETWEEN PRINTING UNITS";
2. U.S. Patent 5,630,363
3. Joint Declaration (1) Under 37 C.F.R. § 1.131 AND (2) Pertaining To Derivation By DeMoore and Printing Research, Inc. of Reissue Applicants' Invention of Bill L. Davis and Jesse S. Williamson;
4. Joint Declaration Submitted Under 37 C.F.R. § 1.57(b) of Bill L. Davis and Jesse S. Williamson;
5. Supplemental Joint Reissue Declaration of Bill L. Davis and Jesse S. Williamson;
6. Summary of Interview Under 37 C.F.R. §1.133;
7. Reissue Declaration of Bill L. Davis and Jesse S. Williamson;
8. Various Patent Statutes;
9. Various Sections of the Manual of Patent Examining Procedure;
10. Prof. W. S. Mott's Draft Report.

I intend to review for the court the basis of some areas of the patent law as they may apply to this lawsuit. Included will possibly be the basics of inventorship including joint inventorship; conception, reduction to practice and diligence; and possibly derivation of invention.

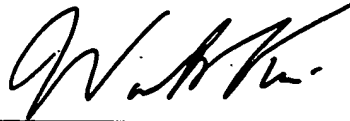
More particularly, I expect to testify that certain employees, possibly including Howard DeMoore and Ronald Rendleman, of Printing Research, Inc. may be, in fact, the inventors of the invention disclosed and claimed in U.S. Patent No. 5, 630,363 (the "'363 patent'"), or at least joint inventors with the currently named inventors of the '363 patent.

I may testify as to the impact of discussions in the summer of 1994 between Messrs. DeMoore and Rendleman of Printing Research, Inc., followed by the sketches of late December 1994 as they apply to conception of the invention disclosed and claimed in the '363 patent.

I may testify as to the derivation of the aforementioned DeMoore and Rendleman invention by employees of Williamson Printing Company as a result of interaction between the above parties.

I may testify as to the scope of the invention in the '363 patent, but I am informed that the necessary facts and subjects in this respect have not yet been discovered in this lawsuit to enable me to opine at this time.

My opinions will be based on the documents I have read, the relation by counsel of certain facts he represented were contained in the Rendleman deposition, and the application of the law to the foregoing.



---

Warren B. Kice  
October 5, 2000

104230-9525750

## **CURRICULUM VITAE**

### **WARREN B. KICE**

Warren Kice is a partner in the Intellectual Property Section of Haynes and Boone. He has over 35 years of practice of intellectual property law, beginning with a period of employment at the United States Patent and Trademark Office in Washington D.C., as a Patent Examiner. He then entered private practice in Washington D. C. before joining Haynes and Boone in Dallas where he founded the Intellectual Property/Technology Section in 1987.

His practice consists primarily of preparation and prosecution of patent and trademark applications before the U.S. Patent and Trademark Office and litigation of patent and trademark matters, including expert witnessing. Other areas of his expertise include patent and trademark licensing, copyright prosecution and litigation and counseling clients regarding all phases of intellectual property. Related activities include presenting papers and speeches on intellectual property and training younger lawyers in the field.

Mr. Kice has written and prosecuted over 500 patent application in a myriad of technological areas, including power plant equipment (boilers, feedwater, heaters, turbines, fluidized beds), fire protection systems, automotive engines, tire manufacturing equipment, downhole oil field equipment, gasoline dispensing and vapor recovery systems, fluid valves, and electrical cables and connectors.

Mr. Kice is a member of the State Bar of Texas, the Intellectual Property Section of the State of Texas, the American Bar Association Sections on Litigation and Patent, Trademark and Copyright Law, the American Intellectual Property Law Association, the Dallas/Fort Worth Patent Law Association, the Licensing Executive Society and The United States Trademark Association.

Born in Ada, Oklahoma, Mr. Kice earned a degree in mechanical engineering in 1959 from the University of Oklahoma and his law degree in 1962 from the University of Oklahoma.

DIRECT DIAL TELEPHONE NUMBER: 214/651-5634

INTERNET ADDRESS: [kicew@hayboo.com](mailto:kicew@hayboo.com)